

Reply to Office Action of: 3/13/2003  
Family Number: P2000J040A

### REMARKS

#### Claim Rejections-35 U.S.C. §103(a)

The Examiner rejected claims 1, 8-11, 13 and 19-20 under 35 U.S.C. §103(a) as being unpatentable over Pedersen (WO 00/12654). Specifically, the Examiner stated that because Pedersen teaches a distillate fuel having the same T90 and other physical properties as the present invention, then Pedersen inherently has the same cold filter plugging point (CFPP) as the fuel of the present invention. Applicant's respectfully disagree.

It is well-settled Federal Circuit law that the extrinsic evidence must make clear that the inherent characteristic being asserted by the Examiner is necessarily present in the product of the prior art. Furthermore, inherency may not be established by probabilities or possibilities. *In re Robertson*, 169 F.3d 743, 49 USPQ 2d 1949 (Fed. Cir. 1999). The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993).

In the present case, the Examiner has only stated that because the fuel of Pedersen shares some physical characteristics with the present invention, the Pedersen inherently has a CFPP of +5°C or less. No further evidence is provided to show that the CFPP property is necessarily present in Pedersen. Despite sharing certain physical characteristics, Pedersen does not share the most important characteristic attributable to achieving a CFPP of +5°C or less--the hydrocarbon structure of the product. As is clearly stated on page 8, lines 19-29 of the present specification, the CFPP is achieved

Reply to Office Action of: 3/13/2003

Family Number: P2000J040A

through the catalytic dewaxing with a selective catalyst of the normal paraffins to isoparaffins. This isomerization of the paraffins is what allows the fuel to achieve superior cold flow properties while maintaining the low emission properties. Contrarily, Pedersen does not catalytically dewax or hydroisomerize the majority of the paraffins in the feed. In fact, Pedersen never even suggests that the feed is predominantly paraffinic or that it should be isomerized to achieve cold flow properties. Pedersen's only focus is on achieving a desired emission property, not on achieving cold flow properties in combination with the emission properties. It is clear, then, that although the products of Pedersen and the present invention share certain physical characteristics, the chemical structure of the products are quite different, and it is this difference (i.e. the predominately isoparaffinic nature of the present invention) that give the present invention superior emission *and* cold flow properties.

Furthermore, Pedersen teaches a composition with less than 1.5wt. % polycyclic aromatics, whereas applicants teach less than 0.1 wt. % polycyclic aromatics. Although the present invention does overlap Pedersen at the low end, the amount of poly aromatics that Pedersen allows on the high end (i.e 0.5 wt.% -1.5 wt.%) would prevent the present invention from achieving a CFPP of +5°C. The polyaromatics would plate out on the filter, causing the CFPP to be much greater. Thus, this is further proof that Pedersen does not necessarily have a CFPP of +5°C or less in all instances. Therefore, based on the reasons presented above, it is clear that Pedersen would not inherently provide a CFPP of +5°C in all instances, and applicant's respectfully request that the rejection be withdrawn.

Reply to Office Action of: 3/13/2003  
Family Number: P2000J040A

The Examiner also rejected claims 21-22 as obvious in view of Pedersen combined with Derr (US 4,684,786). The Examiner stated that it would be obvious to the person of skill in the art to use a second reaction zone in the presence of a catalytic dewaxing catalyst in view of the teachings of Derr. Derr is directed to the catalytical dewaxing of a Fischer-Tropsch wax made from a synthesis gas feed ratio of 1:1 or less. In fact, Derr specifically states that "an important aspect of this invention is directed to converting relatively low H<sub>2</sub>/CO ratio syngas (1/1 or less H<sub>2</sub>/CO ratio)..." col. 2, lines 45-48. The description in Derr further describes the reason this low syngas ratio is critical to Derr's invention. Conversely, the present invention uses a syngas feed ration of at least 1.7, much higher than that of Derr (this limitation is now included in claim 21 per the amendment in this response). Derr's use of a low ratio syngas feed is a distinct and important difference when compared to the present invention. A person of skill in the art is taught away from the present invention in Derr because of this low syngas ratio. Furthermore, the arguments previously presented in regards to Pedersen also should be read as applying to this rejection. Therefore, since a teaching away is evidence of non-obviousness, this rejection should be withdrawn.

Applicants believe that the claims now present in this application to be patentable and that this application is in condition for allowance, and such favorable action is respectfully requested. If any questions or issues remain, the resolution of which the Examiner feels would be advanced by a conference, she is invited to contact Applicants' attorney at the telephone number noted below.

Jul-14-2003 06:01pm From-EXXONMOBIL LAW DEPT

908-730-3649

T-843 P.010/010 F-522

Reply to Office Action of: 3/13/2003  
Family Number: P2000J040A

Respectfully submitted,

Mr. Marin

Mark D. Marin  
Attorney for Applicant(s)  
Registration No. 50,842  
Telephone Number: (908) 730-3271  
Facsimile Number: (908) 730-3649

☒ Pursuant to 37 CFR 1.34(a)

ExxonMobil Research and Engineering Company  
P. O. Box 900  
Annandale, New Jersey 08801-0900

MDM/pmp  
July 14, 2003

FAX RECEIVED  
JUL 15 2003  
TC 1700